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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/004,221	10/26/2001	Keiji Nakagawa	11519-003001	7882
27997	7590	11/18/2003		
PRIEST & GOLDSTEIN PLLC 5015 SOUTHPARK DRIVE SUITE 230 DURHAM, NC 27713-7736			EXAMINER LOPEZ, FRANK D	
			ART UNIT 3745	PAPER NUMBER

DATE MAILED: 11/18/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/004,221

Applicant(s)

NAKAGAWA ET AL.

Examiner

F. Daniel Lopez

Art Unit

3745

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE ____ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4, 10, 11 and 13-15 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 10, 11 and 13-15 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- ☐ Interview Summary (PTO-413) Paper No(s). ____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: .

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on October 6, 2003 has been entered.

Response to Amendment

Applicant's arguments filed September 2, 2003, have been fully considered but they are not deemed to be persuasive.

Applicant argues that Injection Moulding Design discloses a single core, which is incompatible with the figs 7A and 7B (applicant's admitted prior art). The examiner disagrees. Since applicant's admitted prior art includes an exposed core (13), and since Injection Moulding Design teaches a way to protect an exposed core, one of ordinary skill in the injection molding art would recognize the desirability of combining Injection Moulding Design with applicant's admitted prior art.

Applicant concludes that Injection Moulding Design is not from applicant's field of endeavor, by arguing that Injection Moulding Design is a generic discussion of injection molding; but nowhere makes reference to resin pistons. One of ordinary skill in any art would understand how to take general knowledge of how to work that art and apply it to a specific use, such as using the general knowledge of injection molding as apply it to injection molding of a resin piston.

In response to applicant's argument that the purpose of preventing damage to the molding cores is nowhere present in the instant application, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Specification

A substitute specification, filed September 2, 2003 has been entered.

Claim Rejections - 35 USC § 112

Claims 2, 3, 10, and 13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 2 line 2-3, claim 10 line 13-14 claim 13 line 12-13 "the groove facing said communication hole" appears to be wrong, since the groove appears to face away from the communication hole; suggest —away from— be added after "facing".

Claim 3 is indefinite, since it depends from claim 2.

Double Patenting

Applicant is advised that should claim 2 be found allowable, claim 10 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k). The difference between claim 10 and claim 2 is product by process limitations, which do not distinguish claim 10 from claim 2.

Claim Rejections - 35 USC § 103

Claims 1, 11, 14 and 15 are rejected under 35 U.S.C. § 103 as being unpatentable over Applicant's admitted prior art in view of Injection Moulding Design. Applicant's admitted prior art discloses a master cylinder including a resin piston, method of making the resin piston and die for molding the resin piston, wherein the piston comprises a concavity (31) communicating with a through hole (32) by a

communicating hole (33), wherein the piston is injected molded by first and second dies (11, 12) each including a corresponding core (15), with the through hole formed by the corresponding cores; and the concavity and communication hole is formed by a concavity core (13) abutting a flat surface of the corresponding cores (see detail of fig 7); wherein a groove forming an inner wall surface of the through hole, near the communication hole, has a flat surface; but does not disclose that the concavity core is inserted into an impact hole in the corresponding cores.

Injection Moulding Design teaches, for a piece formed by injection molding, using two dies and a core (fig 9.6b), that a tip of the core is inserted into an impact hole of the dies, for the purpose of preventing the core from damage (page 237 paragraph 3).

Since Applicant's admitted prior art and Injection Moulding Design are both from the same field of endeavor, the purpose disclosed by Injection Moulding Design would have been recognized in the pertinent art of Applicant's admitted prior art. It would have been obvious at the time the invention was made to one having ordinary skill in the art to insert a tip of the concavity core of Applicant's admitted prior art into an impact hole in the corresponding cores, as taught by Injection Moulding Design, for the purpose of preventing the core from damage. The result of inserting the tip of the concavity core into an impact hole in the corresponding cores is a burr projecting out from the communicating hole into the through hole

Claim 4 is rejected under 35 U.S.C. § 103 as being unpatentable over Applicant's admitted prior art in view of Injection Moulding Design, as applied to claim 1, respectively, above, and further in view of German 3932248. The modified applicant's admitted prior art discloses all of the elements of claims 4 and 9, but does not disclose that the through-hole includes a projecting part for preventing a stopper pin from touching an inner wall surface near a part communicating with the communicating hole.

German 3932248 teaches, for a master cylinder piston including a concavity (42) communicating with a through hole (34) by a communicating hole (48); that the through-hole includes a projecting part (upper part of right side of piston 12, in fig 2) for

preventing a stopper pin (38) from touching an inner wall surface near a part communicating with the communicating hole.

Since Applicant's admitted prior art and German 3932248 are both from the same field of endeavor, the purpose disclosed by German 3932248 would have been recognized in the pertinent art of Applicant's admitted prior art. It would have been obvious at the time the invention was made to one having ordinary skill in the art to make the through-hole of Applicant's admitted prior art with a projecting part, as taught by German 3932248, for the purpose of preventing a stopper pin from touching an inner wall surface near a part communicating with the communicating hole

Conclusion

Claim 13 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action.

Claims 2 and 3 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dan Lopez whose telephone number is (703) 308-0008. The examiner can normally be reached on Monday-Thursday from 6:30 AM -4:00 PM. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ed Look, can be reached on (703) 308-1044. The fax number for this group is (703) 872-9302. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0861.



F. Daniel Lopez
Primary Examiner
Art Unit 3745
November 17, 2003